

Remarks

This Application has been carefully reviewed in light of the Office Action mailed August 20, 2008 (“Office Action”). Claims 1-40 were pending, Claims 1-8 were rejected, and Claims 9-40 were allowed. Claims 1 has been amended to clarify elements previously present in the claim. Applicant has also added new Claims 41-58. Applicant respectfully submits that no new matter has been added. Applicant respectfully provides the following remarks and respectfully requests reconsideration of Claims 1-8 and allowance of all pending claims.

Allowed Claims 9-40

Applicant appreciates the indication from the Examiner in the Office Action that Claims 9-40 are allowed.

Claims 1-8 are Allowable

The Office Action rejected Claims 1-8 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,642,737 to Parks (“*Parks*”). Applicant respectfully disagrees.

Among other limitations, amended Claim 1 recites “the second arch being uncoupled from the first arch when the user bites down with the oral appliance inserted in the user’s mouth during each of the numerous uses over the extended therapeutic period.” In contrast, *Parks* discloses an anti-snore device with upper and lower members that utilize hook tape to latch the upper and lower members together. (Abstract). According to *Parks*, when the hooks of one member are pressed against the loops of the other member, “the two lock together.” (Col. 2, Lines 53-57 and Col. 4, Lines 50-52). “This connection between the elements resist separation when the elements are moved laterally or horizontally with respect to each other.” (Col. 4, Lines 52-55).

Applicant respectfully submits that the device disclosed in *Parks* in which the upper and lower members are “latched” and “locked” together cannot be construed as disclosing “the second arch being uncoupled from the first arch when the user bites down with the oral appliance inserted in the user’s mouth during each of the numerous uses over the extended therapeutic period.” Rather, *Parks* actually teaches away from this limitation. Independent Claim 1 is allowable for at least this reason and dependent Claims 2-8 are allowable at least

because they depend from allowable Claim 1. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-8.

Claims 41-58 are Allowable

Applicant adds new Claims 41-58. Claims 41-58 are allowable at least for substantially similar reasons as set forth above with regard to Claims 1-8. For example, independent Claim 41 recites, "the second arch being uncoupled from the first arch when the user bites down with the oral appliance inserted in the user's mouth during each of the numerous uses over the extended therapeutic period." Similarly, independent Claim 49 recites, "the arch being uncoupled from any opposing arch when the user bites down with the oral appliance inserted in the user's mouth during each of the numerous uses over the extended therapeutic period." As shown above, *Parks* fails to disclose and in fact teaches away from this element. Independent Claims 41 and 49 are allowable for at least this reason. Dependent Claims 42-48 and 50-58 are allowable at least because they depend from allowable independent Claims. For at least these reasons, Applicant respectfully requests full allowance of Claims 41-58.

CONCLUSION

Applicant respectfully requests reconsideration of Claims 1-8 and full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Russ Crain, Attorney for Applicant at the Examiner's convenience at (214) 953-6803.

The Commissioner is hereby authorized to charge \$688.00 for adding new claims and any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTT S L.L.P.
Attorneys for Applicant



Russell J. Crain
Reg. No. 60,657

Date: November 20, 2008

Correspondence Address:

Customer Number:

05073